

Remarks.

Applicant submits a Request for Continued Examination. Reconsideration and allowance of the above-referenced application is respectfully requested. Applicant submits that no claims or new matter has been added. In the previous action, the Examiner has withdrawn the rejections under 35 U.S.C § 101 and 35 U.S.C § 112 as a result of the amendments to the claims, however, the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(e) still stand.

37 C.F.R. § 1.131

In response to the previous office action, Applicant submitted a declaration under 37 C.F.R. § 1.131. The Examiner asserted that the 1.131 is insufficient because: Applicant failed to provide an evidence of "due diligence" between the dates of January 27, 2000 to December 10, 2002; The Applicants have not given a clear explanation of how these exhibits commensurate with the claimed invention; and General Characteristics of Exhibit A are inconsistent.

Applicant had a teleconference with Examiner Mussa Shaawat and Brian Zender in late September 2009. Applicant's understanding of Examiners Shaawat and Zender suggestions, was that there were three items Applicant should work on for this declaration: (1) For Exhibit A - clear up the confusion regarding the reference citing in conception document; (2) For Exhibit B (screenshot of document properties) – clear up the confusion on the creation and modification date; and (3) For Exhibit C – explain the relevance of the diligence cited.

Applicant discovered that the page numbers and paragraph numbers cited in Exhibit A did not line up with pages and paragraphs in the original document referenced, this was based on that there were different versions of the conception document, all predating Treyz, but different versions nonetheless. Applicant obtained version control and supplied the appropriate version with the appropriate and accurate page and paragraph numbers. Therefore, Applicant believes, by this submission that Exhibit A is commensurate with the scope of Applicant's claims and is explained as such.

With respect to the screenshot, the screenshot in the previous Exhibit B showed a modified date of: January 19, 2000, which is before the prior art referenced, but the Creation date of: January 04, 2002. The reason for the difference in dates is because the file dates change when it was moved from floppy to

another computer. As such, Applicant created a new Exhibit B, where we went back and took a screenshot of the original dates that the documents were modified to show that not only one, but several documents showing a progression in drafting progress were created on or before January 19, 2000. And a second screenshot of another file showing the "Created" date of January 18, 2000 and the "Modified" date of January 18, 2000.

In order to further illustrate due diligence, by this submission, Applicant provides evidence of "due diligence" between the dates of January 27, 2000 to December 10, 2002. To this end, Applicant has revised the declaration illustrating reasonable efforts to achieve an actual reduction to practice or to remove obstacles to its development. With respect to the due diligence proof of emails, documents, presentations, spreadsheets, etc., applicant attempts to explain the relevance of the diligence cited by creating an Exhibit D, which is a grid created with an Excel spreadsheet listing every email and/or document in Exhibit C and how it was relevant towards the due diligence. For example, using the total numbers listed in the 1st column to the right of the "Relevance" column at the top of Exhibit D and that also is explained in the Exhibit D "Column Key", there are "64" emails and/or documents that mention "research and development" of the invention progress. Note that several of the emails and/or documents contain materials relevant to more than one listed subject column (e.g. "research & development" and say, "engineer search") where a "1" is then marked in each column in the row (see Exhibit D).

35 U.S.C. § 102 (e) REJECTION

The Examiner has indicated that Claims 1-24 and 26-41 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,587,835, hereinafter "reference." The Examiner has indicated that with respect to Claim 1, the references teaches a system for providing information to a user comprising: a first database; means for generating a first predetermined content for storage in said first database (see at least col.21 lines 20-40); a second database; means for generating a second predetermined content for storage in said second database (see at least col.22 line 65-col.23 line 6); server means; means for interconnecting said first and second databases to said server means (see at least col.22 line 65-col.23 line 6); a plurality of transceivers; means providing access by each of said transceivers to said server means; and selector means on each said transceiver for selectively accessing said first and second content (see at least abstract, col.9 -col.10, fig.1 and 5).

The Applicant notes the Examiner's rejection. Applicant has attached a declaration under 37 C.F.R. § 1.131, and herein provides that Applicant is the inventor of the subject matter of the rejected claim and submits the appropriate declaration to establish conception of the invention of the subject matter of the rejected claim prior to the effective date of the reference supplied by the Examiner, and a subsequent reduction to practice upon filing United States Provisional Patent Application No. 60/432,808. Applicant further provides evidence of due diligence from at least as early as the provided conception date to at least one reduction to practice date, herein the filing date of the United States Provisional Application No. 60/432,808, as a constructive reduction to practice date. Applicant respectfully requests reconsideration in light of the attached declaration.

35 U.S.C § 103(a) REJECTION

The Examiner has rejected Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over the provided reference. The Examiner notes that as per claim 25, the reference does not expressly teach providing information to send user based on said user's past history within said local environment. However, the examiner takes Official Notice that recommending information to the user based on prior history or shopping history is old and well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the reference to include the teaching of Official Notice, in order to assist the consumer when shopping by recommending items that might be of interest to the consumer based on prior purchases. Applicant wholeheartedly disagrees.

Applicant has effectively removed the reference supplied by the Examiner under the section 35 U.S.C. § 102(e) rejection set forth above by providing a 37 C.F.R. § 1.131 declaration. As such, the elements the Examiner cites for the reference cannot be supplied in order to provide a proper rejection under 35 U.S.C. § 103. MPEP §2143.03 (“[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art”). See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant further contends that the subject matter of Claim 25 is *not* well-known or common knowledge in the art, and is much different than the determination of the court in *In re Ahlert*, 424 F.2d

1088, 1091, 165 USPQ 418, 420 (CCPA 1970), wherein the court held that the Board properly took judicial notice that “it is old to adjust intensity of a flame in accordance with the heat requirement.” See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took “judicial notice of the fact that tape recorders commonly erase tape automatically when new ‘audio information’ is recorded on a tape which already has a recording on it”).

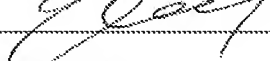
In fact, recommending information to the user based on prior history, wherein that information is collected from a local environment over a network and transmitted to a transceiver, is not well-known and cannot be judicially noticed. At the time of filing, this technology cannot be said to equate to “adjusting the intensity of a flame” or when recording over old material on a tape, erases that previously recorded material. This is evidenced by a search of the United States Patent and Trademark Office patent and patent publications databases, as well a search on Google, in that, use of the relevant terminology leads to Applicant’s patent application publication.

Regardless, because Applicant has effectively removed the cited prior art of record, and that in order to establish prima facie obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art. Thus a rejection under 35 U.S.C. § 103(a) is inappropriate under the circumstances. See Attached 37 C.F.R. § 1.131. See also MPEP §2143.03. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

CONCLUSION

Applicant, accordingly, respectfully requests withdrawal of the rejections of Claims 1-41 and are therefore in a condition for allowance. If the Examiner's next action is other than allowance of Claims 1-41, or the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to contact Applicant at (310) 431-7300 mobile, (818) 554-8007 SMS, or the below, who is not of record, but acts in a representative capacity under the provisions of 37 C.F.R. § 1.34.

Respectfully submitted,

By: 
Matt O'Malley

Dated: 1-4-2010